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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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08/22/2006

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EXAMINER

CHANKONG, DOHM

ART UNIT

PAPER NUMBER

2152

DATE MAILED: 08/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/891,751	MCINTYRE ET AL.	
	Examiner	Art Unit	
	Dohm Chankong	2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4, 7, 10-12, 21, 22, 29 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4, 7, 10-12, 21, 22, 29 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

- 1> This action is in response to Applicant's arguments. Claims 4, 7, 10-12, 21, 22, 29 and 30 are presented for further examination.
- 2> This is a final rejection.

Response to Arguments

I. Response to Applicant's arguments

Applicant argues in substance that: (A) Capps fails to disclose automatically analyzing a digital image media file at a first party for determining if a portion of said at least one digital image file matches an image content identifier; and (B) there is no motivation to combine the references. Applicant's arguments have been considered but are not are persuasive for the following reasons.

A. Capps discloses the functionality of the image content identifier as claimed

As set forth by Applicant, the claims must be read in view of the specification. See Phillips v. AWH Corp., 415 F.3d 1303, 1315 (Fed. Cir. 2005). The specification is "usually...the single best guide to the meaning of a disputed term." Id.

Here, the disputed term is an "image content identifier". According to Applicant's specification, an image content identifier is merely a feature selected from a digital image. Applicant's specification, pg. 6, lines 10-11. In some embodiments, Applicant contemplates that an icon of a person's face serves as the image content identifier. Applicant's specification, pg. 14, lines 5-10. In this regard, Capps discloses a feature of identifying

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characteristics of a person or persons from a digital image and then comparing these characteristics to information from a database [0009, 0010]. Capps discloses that the characteristics used for comparison can be generated from facial recognition software [0052].

In other words, Capps analyzes a digital image file and determines whether a person is located within the image based on comparing what is found in the picture with characteristics stored in a database, such as a person's face. The characteristics of the person are analogous to Applicant's claimed image content identifier because the characteristics are generated from features of a image file (from facial recognition software) [0052]. Additionally, Capps contemplates that the characteristics of a person can be any feature in the digital image [0052].

Applicant's position is further undercut by the fact that Applicant's specification also relies upon facial recognition software to generate image content identifiers. Applicant's specification, pg. 13, line 19 to pg. 14, line 4. This disclosure of the creation image content identifier is similar to the process utilized by Capps to generate the characteristics of a person by which he is identified in a picture. Thus, while Capps does not expressly disclose the exact term "image content identifier", Capps's characteristics of a person that are used to identify a person in an image is clearly analogous in functionality to Applicant's image content identifier. Capps further discloses that an electronic address is associated with these characteristics, which enable transmitting the digital file to the identified person [0005, 0021, 0062].

In addition, Applicant dismisses Goldberg as merely teaching facial identifier functionality. This is clearly relevant to Applicant's image content identifier, who discloses

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using facial recognition software to create image content identifiers. Indeed, Goldberg expressly discloses the creation of an identifier based on the facial identifier functionality. The combination of Capps and Goldberg clearly disclose image content identifier with an associated electronic address as claimed.

B. There is a clear motivation to combine the prior art references because there is an expected beneficial result produced by such a combination

Specifically, Applicant argues that Goldberg fails to provide a suggestion to be combined with an apparatus for annotating an image as described in Lloyd-Jones. Applicant also argues that Lloyd-Jones fails to provide a suggestion to be combined with a system for recognizing a patron's face as described in Goldberg. However, "[t]here are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998). The strongest rationale for combining references is a recognition, expressly or impliedly in the prior art or drawn from a convincing line of reasoning based on established scientific principles or legal precedent, that some advantage or expected beneficial result would have been produced by their combination. In re Sernaker, 702 F.2d 989, 994-95 (Fed. Cir. 1983). It is clear that the motivation to combine references does not need to come only from the references themselves.

Applicant's arguments are not persuasive for two reasons. First, Applicant's analysis of the combination of references is misplaced. The Goldberg and Lloyd-Jones references were combined with the primary reference, Capps. In other words, Capps' system is being modified in light of Goldberg and Lloyd-Jones. Thus, there must be proper motivation to combine the teachings of Goldberg and Lloyd-Jones with Capps' system.

Second, the motivation to combine comes from knowledge of persons of ordinary skill in the art and from the clear expectation that such a combination would provide a beneficial result. As would be clear to one of ordinary skill in the art, both Goldberg and Lloyd-Jones would improve Capps' invention. For example, with respect to the combination of Goldberg and Capps, both references are directed towards providing a system for recognizing a person's face in an image using facial recognition software [see Capps, 0052 & Goldberg, 0142-0144]. Goldberg teaches what is obvious in Capps, that the use of facial recognition software requires an identifier for each person that is recognized. This identifier is analogous to Applicant's claimed image content identifier.

With respect to the Capps and Lloyd-Jones combination, Lloyd-Jones was relied upon for the teaching of automatically forwarding an image from a first party to an electronic address of a second party. Like Goldberg, Lloyd-Jones explicitly teaches what was already obvious in Capps. Capps discloses an action button process enabling communications such as forwarding of the image to a second party [0066]. Lloyd-Jones expressly discloses automatically forwarding an image from a first party to an electronic address of a second party [0039]. This feature improves Capps because such functionality allows multiple images associated with a second party to be sent more easily [see Lloyd-Jones, 0005].

II. Conclusion

For the foregoing reasons, Applicant's arguments are not persuasive. The claim rejections set forth in the previous action, filed 3.27.2006, are maintained.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3> The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4> Claims 4, 7, 10, 12, 20-22 and 29-30 are rejected under 35 U.S.C § 103(a) as being unpatentable over Capps, U.S Patent Publication No. 2002|0111813 ["Capps"], in view of Lloyd-Jones, U.S Patent Publication No. 2002|0055955 ["Lloyd-Jones"], in further view of Goldberg, U.S Patent Publication 2004|0008872.

5> As to claims 4, 7, 10, 12, 20-22 and 29-30, see response above and rejections set forth in Non-final rejection, filed 3.27.2006 and Final Rejection, filed 8.9.2005.

6> Claim 11 is rejected under 35 U.S.C § 103(a) as being unpatentable over Capps, Lloyd-Jones and Goldberg, in view of Davis et al, U.S Patent Publication 2002/0001395 ["Davis"].

7> As to claim 11, see response above and rejections set forth in Final Rejection, filed 8.9.2005.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

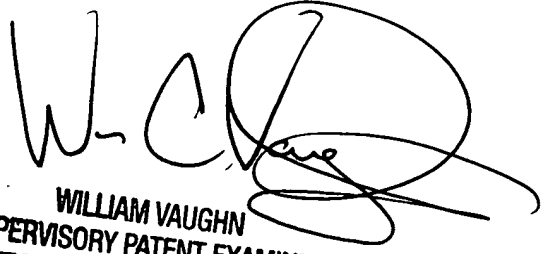
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dohm Chankong whose telephone number is 571.272.3942. The examiner can normally be reached on Monday-Thursday [7:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571.272.3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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